

Appl. No. 09/516,949  
Amdt. dated February 27, 2004  
Reply to Office Action of August 27, 2003

PATENT

**REMARKS/ARGUMENTS**

**Discussion of Claim Rejections Under 35 U.S.C. § 112**

Claim 15 was rejected under 35 U.S.C. § 112 as having insufficient antecedent basis for the term "the customer." Applicant amends Claim 15 to correct a typographical error identifying the Claim from which Claim 15 depends. Applicant amends Claim 15 to depend from Claim 13 rather from Claim 12. Claim 13 provides the proper antecedent basis for the term "the customer" appearing in Claim 15. Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112 in light of the claim amendment.

**Discussion of Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1-5 and 8-20 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,282,522 to Davis, et al. (hereinafter Davis) in view of U.S. Patent No. 5,987,439 to Gustin, et al. (hereinafter Gustin). Claims 6-7 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Davis in view of Gustin, and further in view of the *Regional SmarTrip System* document (hereinafter SmarTrip). The Office Action dated August 27, 2003 contends the references disclose all aspects of the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the references, either alone or in combination, must teach or suggest all claim limitations. Additionally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Applicant respectfully contends the references, either alone or in combination fail to teach or suggest all claim limitations. Claim 1, as amended, includes the feature that "the smart card [can be] configured to operate in at least one of a plurality of benefit types." Additionally, Claim 1 features express vending machine. The express vending machine includes "a user interface for each said patron to request the benefits and a benefit type from the plurality of benefit types." These features are not disclosed or suggested by the cited references.

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Applicant's specification discloses a smart card that can be configured to operate in at least one of a plurality of benefit types. For example, a particular smart card may operate as one of a plurality of valid transit pass types, including a one day pass, a rail short trip pass, and fast rail pass. *See* Specification at page 8 line 34 through page 9 line 2. Additionally, the smart card may be configured to operate in both rail and parking benefit types. *See* Specification at page 8, ll. 29-31.

Moreover, the express vending machine includes a user interface where a patron can request that the smart card be configured in a particular benefit type. "The pass type change is initiated at the express vending machine and does not require the smart card to be returned to a point of issue for exchange." Specification at 9, ll. 2-4 (reference numbers omitted). Furthermore "[t]he benefits system allows a patron to 'toggle' between pass types while maintaining an unrestricted cash purse." *Id.* at ll. 4-6 (reference numbers omitted). Thus, not only can the smart card be configured for at least one of a plurality of benefit types, but a patron can control the benefit type by way of a user interface on the express vending machine.

Davis discloses only one possible configuration for the smart card. Davis discloses that the smart card is a stored-value card. Indeed, Davis uses the terms "smart card" and "stored-value card" interchangeably. "For the purposes of this description, the smart card with a stored-value application used in embodiments of the invention will be simply referred to as a 'stored-value card'." Davis at Col. 6, ll. 36-39. Davis discusses alternative embodiments of stored-value cards, such as those for small dollar amount transactions or those for storing frequent flyer points, but does not disclose or suggest a smart card that can be configured to at least one of a plurality of benefit types.

Moreover, because Davis fails to disclose or suggest a smart card configured for at least one of a plurality of benefit types, Davis also fails to disclose an express vending machine that has a user interface that allows a patron to request "a benefit type from the plurality of benefit types" as claimed. Davis fails to disclose a benefit type being written to the smart card because Davis only discloses one type of value stored on any particular card.

Gustin also fails to disclose or suggest the claim features relating to a plurality of benefit types on a smart card and the patron's ability to request a particular benefit type via a user

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interface of an express vending machine. Instead, Gustin discloses how odd denominations of cash may be accounted in an ATM system that is configured to allow bill payment or vending. *See generally*, Gustin Abstract. The Office Action identifies a portion of Gustin discussing electronic benefits, but the cited portion fails to disclose or suggest a plurality of benefit types or an express vending machine where a patron can request a particular benefit type.

Thus, Applicant contends Claim 1 is allowable because the cited references fail to disclose or suggest all claimed features. Applicant respectfully request reconsideration and allowance of Claim 1.

Claim 16, as amended, similarly includes the feature where the smart card is configured "for a particular benefit type from a plurality of benefit types." Thus, Applicant contends Claim 16 is allowable for the reasons presented above in relation to Claim 1, and respectfully requests reconsideration and allowance of Claim 16.

The SmarTrip document similarly fails to disclose configuring a smart card for a particular benefit type from a plurality of benefit types. The SmarTrip document fails to disclose or suggest any type of express vending machine, much less an express vending machine that includes a user interface that allows a patron to request a benefit type. Thus, the SmarTrip document fails to provide claim features not disclosed by the other cited references.

#### Discussion of Dependent Claims

Claims 2-15 and 17-20 depend, either directly or indirectly, from one of Claims 1 or 16 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Thus, Applicant respectfully requests reconsideration and allowance of Claims 2-15 and 17-20.

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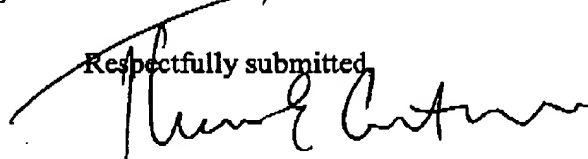
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**CONCLUSION**

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The claimed features and supporting remarks are only provided to illustrate one potential feature not disclosed or suggested in the cited references. The claims may be patentable over the cited references based on features and supporting arguments not provided above. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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